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Jeffery Carter

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Pfizer, Inc
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St. Louis, MO 63141

EXAMINER

CHANG, CELIA C

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

1. Applicant's election without traverse of group A claims 9-11 in the reply filed on Sept. 22, 2006 is acknowledged. Applicants' request to modify the restriction requirement dated Sept. 15, 2006 based on structural difference be withdrawn and be replaced by the examination of all the species for which applicants considered to be one inventive concept, has been acceptable.

Claims 9-11 are examined. Claims 1-8, 12-33 are withdrawn from consideration per 37 CFR 1.142(b).

2. Applicants attention is drawn to the non-rejoinable nature of claims 27-33 (group B).

In the restriction requirement, it was clearly delineated that:

"Applicants are reminded of propriety of process of use claims in consideration of the "reach-through" format, which is drawn to mechanistic, receptor binding or enzymatic functionality. Reach through claims are considered lacking of descriptive and enabling support from the specification. Thus, rejoinable process of use claims are those with particular disease named with efficacy support from the specification for treating the particular disease. **Failure to do so may result in a loss of the right to rejoinder.**"

In so far as claims 27-33 wherein applicants intend to be rejoined with the compound claims were any of the compounds found to be allowable, the 112 issue of the claims must be obviated. Please note that there is no evidence of record that the species of claims 9-11 would have obvious variation of potency as any other known COX-2 inhibitor and be able to treat ***all COX-2 mediated disorders***. Especially, the state of the art indicated (see US 20030013739, US 20030114418 etc. not an exhausted listing) conditions related to and mediated through COX-2 are increasing continuously. A claim to all cox-2 mediated conditions would be considered a reach through to the continuous development of the field.

Only specific disorder disclosed in the specification, which have been documented at the time the invention was made that such specific condition has been treated by structural analogous compounds with similar potency as the instant compounds, may be presented for rejoinder were some of the instant compounds find neither anticipation nor obviousness over the art.

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter et al. WO 98/47890.

Determination of the scope and content of the prior art (MPEP §2141.01)

Carter et al. '890 disclosed benzopyranyl compounds as COX-2 inhibitors. A detailed description of the genus coupled with well exemplified species were disclosed.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the instantly claimed species and the Carter et al. '980 reference is that the instant species are fully embraced by the generic description but are position isomers or analogous picking and choosing substituted compounds which are not particularly named by the examples of the reference.

Finding of prima facie obviousness—rational and motivation (MPEP §2142-2143)

One having ordinary skill in the art would find the instant species prima facie obvious over the reference **because** not only a detailed description of the generic concept was disclosed by the reference, the well exemplified compounds would guide one skilled in the art to pick and choose the instant claims. Particularly, on pages 32-52 multiple species of 6,8-disubstituted benzopyrans and 6,7,8-trisubstituted benzopyrans were disclosed. The very closely structural analogous compounds can be found by comparing claim 11, p.749 2nd compound from the bottom of the page to the Carter et al. '890 p. 46, lines 13-14 wherein the instant claims is 8-chloro, 6-iodo-2-CF₃-chromene-3-carboxylic acid, while the prior art compound is 6-chloro, 8-iodo-2-CF₃-chromene-3-carboxylic acid, reverse position isomer; or by comparing claim 11, p. 753, 8th compound from the bottom of the page to the Carter et al. '890 p.48, lines 8-9 wherein

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the instant claims is 8-chloro, 6-cyano-2-CF₃-chromene-3-carboxylic acid, while the prior art compound is 6-chloro, 8-cyano-2-CF₃-chromene-3-carboxylic acid, reverse position isomer. Guided by the well exemplified compounds of Carter et al. '890 on pages 32-52 of the variation in position with broad spectrum of substituents, the position isomerism of selected species within the guidelines of the generic teaching rendered all the claimed compounds *prima facie* obvious. In absence of unexpected results, there is nothing unobvious in choosing some among many. In *re* Lemin 141 USPQ 814.

4. Claims 9-11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,034,256 (cited on 1449). Although the conflicting claims are not identical, they are not patentably distinct from each other because the generic claim 1 of the issued patent fully embraced the instant species and the species claims with multiple variations of position isomers and equivalent optional choices of substituents rendered the instant specific species *prima facie* obvious. The same rational as delineated in section 3 for the patent family of US 6,034,256 by WO 98/47890 is also applicable here and herein incorporated by reference.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 9-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the elected claims 9-12 of copending Application No. 10/801,446 in view of claims 1-27 of US 6,034,256 and claims 1-2 of US 7,138,411.

This is a provisional obviousness-type double patenting rejection.

Determination of the scope and content of the copending claims

Both the instant claims and the copending claims are substituted benzopyranyl compounds with COX-2 inhibitory activity.

Ascertainment of the difference between the two sets of claims

The difference between the two sets of copending claims is that the instant claims are drawn to variation of substituents selected from halogen, unsubstituted or substituted alkyl, alkenyl, alkynyl, arylC₁₋₆alkoxy, heteroarylC₁₋₆alkoxy etc.; while the copending claims in addition to the same category of substituents, also included substituents such as aryloxy and heteroaryloxy etc. The claimed scope of US 6,023,256 encompassed the scope of variation of substituents selected from halogen, unsubstituted or substituted alkyl, alkenyl, alkynyl, arylC₁₋₆alkoxy, heteroarylC₁₋₆alkoxy etc. while the claimed scope of US 7,138,411 included the equivalent additional optional substituents such as aryloxy and heteroaryloxy etc.

Finding of prima facie obviousness—rational and motivation

One having ordinary skill in the art in possession of claims 1-27 of US 6,023,256 and claims 1-2 of US 7,138,411 would be in possession of all the variations of the analogous compounds for the COX-2 inhibitory compounds. Guided by the species claims and the well exemplified compounds of the specification of '256 or '411, one having ordinary skill would find the entire genus of claims for '256 or '411 delineated thus including the instant variation of species between claims 9-11 of the instant claims and claims 9-12 of the copending claims. Especially, applicants considered the species claims to be one inventive concept with request to withdraw the restriction among the compounds.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.


Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie, Ph. D., can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Dec. 6, 2006


Celia Chang
Primary Examiner
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